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| 09/551,110      | 04/18/2000  | Kevin J. Gaughan     | DF-7159             | 2550             |

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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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2697

DATE MAILED: 07/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/551,110

Applicant(s)

GAUGHAN ET AL.

Examiner

Matthew R Demicco

Art Unit

2697

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 44-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Drawings*

1. This application lacks formal drawings. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 44-57 and 59-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,923,379 to Patterson in view of U.S. Patent No. 5,940,074 to Britt, Jr. et al. and further in view of U.S. Patent No. 5,991,308 to Fuhrmann et al.

Regarding Claim 44, Patterson discloses a web television comprising a display (Col. 3, Lines 60-64), a tuner (See Figure 4, 12), wherein the tuner is arranged to select television video for display on the display (Col. 2, Lines 52-55), an Internet module (26 and 40). The Internet module is arranged to supply Internet video (Col. 3, Lines 48-56) for display on the display (Col. 3, Lines 21-23). The Internet video is derived from Internet communications between the web television and the Internet content provider through modem (40) as is well known in the art. It is inherent in such a system that the Internet module be a software program running on the microprocessor (26). Further

disclosed is a television controller (14, 16, 26) that is arranged to communicate with the Internet module (See Figure 4, Interconnection between 16 and 26). It is inherent in such a system controlled by a microprocessor (26) that a second software code must be implemented to control the television tuner. What is not disclosed, however, is that the television controller is arranged to process a message between the television controller and the Internet module indicating identification of one of the first and second software codes. Britt discloses a web television system (See Figure 3) with an Internet module that executes a software program (Col. 4, Lines 25-27). Britt further discloses that this application software, running on a CPU, may be updated via download from the network (Col. 7, Lines 21-24). The web television system of Britt is further aware of the version of software it is running (Col. 9, Lines 19-22). This information is necessary in order that the web television may update itself automatically with the latest code versions available on the network. Britt is evidence that ordinary workers in the art would recognize the benefit of being able to update software versions automatically in a web television. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the web television of Patterson with the version information and automatic update of Britt in order that the web television is always using the latest software with the latest features and bug fixes. Patterson in view of Britt however, fail to disclose the transmission of the identification information between software programs. Fuhrmann discloses a cable television system with bi-directional data communication wherein a software revision number is transmitted from a client to a receiver in order for the receiver to check its software version for compatibility (Col. 95,

Lines 11-22). Fuhrmann is evidence that ordinary workers in the art would recognize the benefit of being able to compare software revision information between programs in order to guarantee compatibility. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the web television with automatic software version updating of Patterson in view of Britt with the communication of software revision information transmission of Fuhrmann in such that the web television would be able to compare revision information between newly downloaded software versions for compatibility purposes. This reads on the claimed television controller being arranged to process a message between the television controller and the Internet module indicating identification of one of the software codes.

Regarding Claims 45-47, Patterson in view of Britt and further in view of Fuhrmann disclose a system as stated above in Claim 44. Fuhrmann discloses the identification comprises a revision number as stated above. A version number, as is well known in the art, often consists of a major and minor number, such as 1.2. The first number indicates the release version, while the digit to the right of the decimal place indicates the revision thereof. Therefore, version and revision numbers are often inherently tied together and consequently synonymous in the art.

Regarding Claim 48, Patterson in view of Britt and further in view of Fuhrmann disclose a system as stated above in Claim 44. Depending on which software was recently upgraded (Internet or television), the identification message could identify either one of the software codes. This could be the television controller transmitting its identification to the Internet module. In the system of Patterson, both Internet and

television modules are controlled from a single Microprocessor (26). In such a system, the identification message may consist of an inter-process communication between two different software codes using a shared memory or dedicated messaging protocol built into the operating system.

Regarding Claims 49-51, Patterson in view of Britt and further in view of Fuhrmann disclose a system as stated above in Claim 48. The identification could comprise a version number or revision number as stated above due to the fact that in the art, version and revision numbers are synonymous.

Regarding Claim 52, Patterson in view of Britt and further in view of Fuhrmann disclose a system as stated above in Claim 51. Fuhrmann discloses the use of the version/revision number of the software code to determine compatibility between software modules as stated above. It is inherent that this system could be used to determine which features of a particular piece of software are compatible with another piece of software in addition to compatibility between the programs in their entirety.

Regarding Claim 53, Patterson in view of Britt and further in view of Fuhrmann disclose a system as stated above in Claim 52. Because the Internet module is aware of the capabilities of the television module through the version information as stated above, it would inherently only make use of the features it has that are compatible. Failing to perform this would lead to an incompatibility, which may cause the system to crash. This reads on the claimed Internet module being arranged to initialize the features that are compatible with the second software.

Regarding Claim 54, Patterson in view of Britt and further in view of Fuhrmann disclose a system as stated above in Claim 44. Depending on which software was recently upgraded (Internet or television), the identification message could identify either one of the software codes. This could be the Internet controller transmitting its identification to the television module. In the system of Patterson, both Internet and television modules are controlled from a single Microprocessor (26). In such a system, the identification message may consist of an inter-process communication between two different software codes using a shared memory or dedicated messaging protocol built into the operating system.

Regarding Claim 55-57, Patterson in view of Britt and further in view of Fuhrmann disclose a system as stated above in Claim 54. The identification could comprise a version number or revision number as stated above due to the fact that in the art, version and revision numbers are synonymous.

Regarding Claim 59, Patterson in view of Britt and further in view of Fuhrmann disclose a system as stated above in Claim 44. Fuhrmann teaches that receiving unit can request data from a sending unit (Col. 95, Lines 7-10). Therefore, the Internet module could make a request of the television controller for information regarding identification information, such as the identification of the second software code, as stated above.

Regarding Claim 60, Patterson in view of Britt and further in view of Fuhrmann disclose a web television comprising a display, a tuner arranged to select television video for display, a television controller, an internet module that is arranged to supply internet video for display on the display wherein the Internet video is derived from Internet

communications between the web television and Internet content provider, wherein the television and Internet controllers are arranged to communicate messages with one another, and wherein one of the messages contains software identification information as stated above in Claim 1.

Regarding Claims 61-63, Patterson in view of Britt and further in view of Fuhrmann disclose a web television as stated above in Claim 60. The identification could comprise a version number or revision number as stated above due to the fact that in the art, version and revision numbers are synonymous.

4. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson in view of Britt, Jr. et al. and further in view of Fuhrmann et al. and further in view of well-known prior art.

Regarding Claim 58, Patterson in view of Britt and further in view of Fuhrmann disclose a system as stated above in Claim 44. Fuhrmann further discloses a system wherein the receiver of a message receives a "hello" message from the sender (Col. 95, Lines 11-16). Official Notice is hereby taken that it is well known in the art of digital communication that a handshake, involving a "hello" message followed by a reply from the recipient, is necessary when beginning a conversation or data transmission. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the system of Patterson in view of Britt and further in view of Fuhrmann with the handshake of the well-known prior art in order to establish reliable digital communications. This reads on the claimed television controller being



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arranged to send a signal to the Internet module, wherein the signal indicates that the controller is going to send a message, and wherein the Internet modules responds to the signal with an acknowledgement indicating to the television controller that it may send a message.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 44 and 60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16, 26, 30, 32 and 42 of U.S. Patent No. 6,073,171. Although the conflicting claims are not identical, they are not patentably distinct from each other because all elements of the claimed invention are present in the prior art including a display, a tuner, an internet module, a television controller, and an identification message containing version information being transmitted from one software code to another.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 308-5359 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



mrd  
June 23, 2003

